

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed October 2, 2006 rejected claims 1-3, 6-8, 15, and 21-45. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1-3, 6-8, 15, and 21-45 are pending. More specifically, claims 1-3, 15, 21-23, 30-33, and 35 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 3 and 30-33 are rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3, 6-8, 15, and 21-45 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). These rejections are respectfully traversed.

II. Rejections Under 35 U.S.C. §112

The Office Action rejects claims 3 and 30-33 under 35 U.S.C. §112, Second Paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In an effort to address the Examiner's concerns, claim 3 has been amended to recite "checking is performed periodically." In view of this amendment, Applicant respectfully submits that the rejection to claim 3 should be withdrawn.

Additionally, claims 30-33 have been amended to recite "the location of the searching of the message." In view of this amendment, Applicant respectfully submits that the rejection to claims 30-33 should be withdrawn.

III. Rejections Under 35 U.S.C. §102(e)

A. Claims 1-3, 6-8, 15, and 43

The Office Action rejects claims 1-3, 6-8, 15, and 43 under 35 U.S.C. §102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1, as amended, recites:

1. A method for automatically managing an electronic mail server application on a host computer, comprising:
 - checking an electronic mail message against a predetermined criteria;
 - determining whether the message has been previously compressed;**
 - compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and
 - storing the compacted electronic mail message.(Emphasis added).

Applicant respectfully submits that claim 1 patentably defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Shaffer* does not disclose, teach, or suggest at least **determining whether the message has been previously compressed**. *Shaffer* compresses files without determining whether the file was previously compressed. Therefore, *Shaffer* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over the cited references of record, dependent claims 2-3, 6-8, 15, and 43 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, 15, and 43 contain all the features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-3, 6-8, 15, and 43 are patentable over *Shaffer*, the rejection to claims 2-3, 6-8, 15, and 43 should be withdrawn and the claims allowed.

B. Claims 21-23, 26-28, 30-34, and 44

The Office Action rejects claims 21-23, 26-28, 30-34, and 44 under 35 U.S.C. §102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21, as amended, recites:

21. A method for managing a user's electronic mailbox on a computer, comprising:
performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria;
determining if the electronic mail message has been previously compressed;
compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein ~~the step of~~ compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and
storing the compressed electronic mail message.
- (Emphasis added).

Applicant respectfully submits that claim 21 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 21, as amended, is allowable for at least the reason that *Shaffer* does not disclose, teach, or suggest at least **determining if the electronic mail message has been previously compressed**. *Shaffer* compresses files without determining whether the file was previously compressed. Therefore, *Shaffer* does not anticipate independent claim 21, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 21, as amended, is allowable over the cited references of record, dependent claims 22-23, 26-28, 30-34, and 44 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, 30-34, and 44 contain all the features of

independent claim 21. Therefore, since dependent claims 22-23, 26-28, 30-34, and 44 are patentable over *Shaffer*, the rejection to claims 22-23, 26-28, 30-34, and 44 should be withdrawn and the claims allowed.

C. Claims 35-42 and 45

The Office Action rejects claims 35-42 and 45 under 35 U.S.C. §102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 35, as amended, recites:

35. A computer readable medium with logic embedded therein for executing on a computer for managing a electronic mailbox on a computer comprising:
logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria;
logic configured to determine if the message has been previously compressed;
logic configured to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns; and
logic for storing the compressed electronic mail message.
(Emphasis added).

Applicant respectfully submits that claim 35 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 35, as amended, is allowable for at least the reason that *Shaffer* does not disclose, teach, or suggest at

least **logic configured to determine if the message has been previously compressed**. *Shaffer* compresses files without determining whether the file was previously compressed. Therefore, *Shaffer* does not anticipate independent claim 35, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 35, as amended, is allowable over the cited references of record, dependent claims 36-42 and 45 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 and 45 contain all the features of independent claim 35. Therefore, since dependent claims 36-42 and 45 are patentable over *Shaffer*, the rejection to claims 36-42 and 45 should be withdrawn and the claims allowed.

IV. Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-3, 6-8, 15, and 21-45 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

/BAB/

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